

26 OCT 2009



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KEUSEY, TUTUNJIAN & BITETTO, P.C.
20 CROSSWAYS PARK NORTH
SUITE 210
WOODBURY NY 11797

In re Application of	:	DECISION
LOSIO et al.	:	
Application No.: 10/598,859	:	
PCT No.: PCT/IB2005/000656	:	
Int. Filing Date: 15 March 2005	:	
Priority Date: 15 March 2004	:	
Attorney Docket No.: 048826/315332	:	
For: COMPOSITE FOOTWEAR INSOLE,	:	
AND METHOD OF MANUFACTURING	:	
SAME	:	

This decision is in response to applicants' renewed petition under 37 CFR 1.497(d) filed 28 August 2009.

BACKGROUND

On 15 March 2005, applicant filed international application PCT/IB2005/000656, which designated the United States and claimed a priority date of 15 March 2004. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 29 September 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 15 September 2006.

On 13 September 2006, applicant filed a transmittal letter for entry in to the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 17 June 2008, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that a declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 05 August 2008, applicant filed a petition under 37 CFR 1.497(d) which was accompanied by, *inter alia*, a statement from Ireneo Braghin and an English translation thereof.

On 20 November 2008, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.497(d). Specifically, it was noted that the statement of Ireneo Braghin (English translation) did not state that any error in inventorship in the international application occurred with deceptive intention on his part, that no mention was made in the petition regarding whether an assignment had been executed, that if an assignment had been executed, the written consent of the assignee was required, and that a proper showing under 37 CFR 3.73(b) was required if an assignment has been executed. The decision also noted that the declaration of inventors filed 05 August 2008 was not in compliance with 37 CFR 1.497(a)-(b) because the filing date indicated for the executed specification was incorrect.

On 14 May 2009, applicants filed a renewed petition under 37 CFR 1.497(d) which was accompanied by, *inter alia*, a petition/fee for a four-month extension of time, a new declaration of the inventor, a statement from Ireneo Braghin, and a consent of assignee statement.

On 17 August 2009, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.497(d). Specifically, it was noted that a proper showing under 37 CFR 3.73(b) had not been provided.

On 28 August 2009, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a showing under 37 CFR 3.73(b).

DISCUSSION

37 CFR 1.497(d), provides:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92^{bis} subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in Sec. 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

As noted in the decision mailed 20 November 2008, item (2) has been satisfied and item (4) is not required.

As noted in the decision mailed 17 August 2009, item (1) has been satisfied.

Item (3) has now been satisfied. The showing under 37 CFR 3.73(b) filed 28 August 2009 is proper.

Declaration of the Inventor

The declaration of the inventor filed 14 May 2009 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED** for the reasons set forth above.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application in accordance with this decision including processing the application in the name of Massimo Losio as inventor.

/Daniel Stemmer/

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301